

REMARKS

Claims 1-28, 30 and 31 are pending in the present application. In summary of the outstanding Office Action, claims 1-28, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,572,442 (Schulhof et al.) in view of U.S. Patent No. 6,272,636 (Neville et al.). Amendments to the claims have been made herein to correctly define the scope of the invention and typographical errors, and are not in reponse to arguments made or any references cited by the Examiner. No new matter has been added.

Reconsideration of the outstanding rejections to the claims is respectfully requested in view of the the following remarks.

Claim rejections under 35 U.S.C. §103

Claims 1-28, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof et al. in view of U.S. Patent No. 6,272,636 (Neville et al.).

Regarding claim 1, the Office Action states that the language of claim 1 of “permitting the at least one customer household to select previously recorded music selections, that were previously recorded by the at least one customer household in the storage medium, for unrestricted playback” is not recited by Schulhof, but that it is taught by Neville. However, Nelville teaches using a “metered digital product” (col. 13, line 4) to allow a user to use the digital product for an “evaluation period” (col. 13, lines 32-33). This is opposed to permitting a music selection for “unrestricted playback” according to claim 1. In particular, Schulhof states “If...the server/clearinghouse determines that an evaluation period has expired, the server does not transmit the unlock key to the end-user, but sends an ‘end of evaluation’ message. The application cannot then execute on the end-user computing device.” (Col. 13, lines 31-35). Applicant respectfully submits that restrcting use of the digital product to an “evaluation period” as is stated in Schulhof is not “unrestricted playback” as stated in claim 1.

Thus, for the reasons above and others, Applicant respectfully submits that all the limitations of claim 1 are not taught or suggested by Schulhof et al.

Regarding claim 2-18, 20, 21, 23, 26, 27 and 31, the Office Action gives the same reason as for claim 1 in rejecting these claims. Thus, Applicant submits that all the limitations of claims 2-18, 20, 21, 23, 26, 27 and 31 are not taught or suggested by Schulhof et al. for the same reasons as claim 1.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP § 2142. Since all the limitations of claims 1-28, 30 and 31 are not taught or suggested by Schulhof et al., Neville et al., or any combination thereof, for the same reasons presented above, withdrawal of the rejections under 35 U.S.C. § 103(a) for claims 1-28, 30 and 31 is earnestly solicited.

CONCLUSION

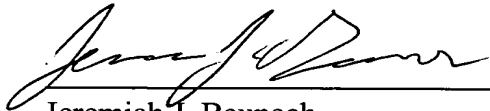
Applicant believes that the present Amendment is responsive to each point raised by the Examiner in the office action and Applicants submit that claims 1-28, 30 and 31 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the Examiner’s earliest convenience is earnestly solicited. However, should the Examiner find the claims as presented herein to not be allowable for any reason, Applicant’s undersigned representative earnestly requests a telephone conference at (206) 332-1392 with both the Examiner and the Examiner’s Supervisor to discuss the basis for the Examiner’s continued rejection in light of the Applicant’s arguments presented herein. Likewise, should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicant’s undersigned representative would very much appreciate a telephone conference to discuss these issues.

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PATENT

Also, this application is related to U.S. patent application 09/707,273, filed November 6, 2000, in which the Examiner in that case cited: U.S. Patent No. 5,527,442 (Schulhof), U.S. Patent No. 5,483,535 (McMillen), Examiner's purported official notice, U.S. Patent No. 6,061,440 (Delaney), and U.S. Patent No. 6,229,453 (Gardner) in rejecting the claims.

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